

REMARKS

This Reply and Amendment is intended to be completely responsive to the Non-Final Office Action dated May 7, 2003. Claims 1-34 are pending in this Application. Claims 1-34 stand rejected. Applicant respectfully requests reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-8, 13-21, 26-29, 31-32, and 34 are currently being amended.

This amendment adds, changes and/or deletes claims in this Application. A detailed listing of all claims that are, or were, in the Application, irrespective of whether the claim(s) remain under examination in the Application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. § 112

On page 2 of the Office Action, the Examiner rejected Claims 4, 10, 11, 13, 23, and 27 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4

On page 2 of the Office Action, the Examiner stated that “it is not clear what is meant by a ‘footprint’.” Claim 4 has been amended and does not recite the term “footprint.” Accordingly, the Applicant requests withdrawal of this rejection.

Claims 10 and 23

On page 2 of the Office Action, the Examiner stated that “the phrase ‘configured to be attached’ renders the claim indefinite because the claim does not recite how the article is configured to be attached to a support structure.” As explained in MPEP § 2173.05(g), “[t]here is nothing inherently wrong with defining some part of an invention in functional terms.

Functional language does not, in and of itself, render a claim improper.” See In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). Applicant believes there is nothing improper about using functional language to define structural attributes of parts of the article in Claims 10 and 23. See also In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) (holding that limitations such as “members adapted to be positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly). Accordingly, the Applicant requests withdrawal of this rejection.

Claim 11

On page 2 of the Office Action, the Examiner stated that “the phrase ‘configured to receive a fastening member’ is not clear because the claim does not recite how the base of the article is configured to receive a fastening member.” As explained in MPEP § 2173.05(g), “[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” See In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). Applicant believes there is nothing improper about using functional language to define structural attributes of parts of the article in Claim 11. See also In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) (holding that limitations such as “members adapted to be positioned” serve to precisely define present structural attributes of interrelated component parts of the claimed assembly). Accordingly, the Applicant requests withdrawal of this rejection.

Claim 13 and 27

On pages 2-3 of the Office Action, the Examiner stated that it is not clear what is meant by “one characteristic is material.” The Applicant has amended Claims 13 and 27. Claims 13 and 27 no longer refer to “material” or “a material.” Accordingly, no amendment of Claim 13 or 27 is necessary. The Applicant requests withdrawal of this rejection.

Claim Rejections – 35 U.S.C. § 102

On page 3 of the Office Action, the Examiner rejected independent Claim 1 and dependent Claims 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”).

Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

Claim 1 has been amended. Claims 10 and 11 depend from Claim 1 as amended. Claim 1 now recites an “article for association with a motor vehicle” comprising in combination with, among other elements, “elements coupled to the base, wherein the elements have at least two characteristics including color, shape, surface profile, surface finish, outline, material, and indicia, and wherein unique configurations of the article may be created by selecting elements with different combinations of the at least two characteristics.” The “article” as recited in Claim 1, as amended, is not identically disclosed by Van Houten. Accordingly, Claim 1 (and corresponding Claims 10 and 11) are not anticipated by Van Houten under 35 U.S.C. § 102(b) and are patentable.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of Claims 1, 10 and 11.

Claim Rejections – 35 U.S.C. § 103

On page 4 of the Office Action, the Examiner rejected independent Claim 1 and dependent Claims 2-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”). The Examiner acknowledged that Van Houten differs from the claimed invention in that Van Houten does not specifically disclose the “profiles, color, footprint, and indicia associated with the inserts” of Claims 1-14. However, the Examiner stated that Van Houten teaches the “decorative inserts may be replaceable or interchangeable.” The Examiner thus concluded that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the interchangeable inserts of Van Houten with

various designs, shapes, colors and profiles in order to decorate or accent a vehicle according to the users individual taste.”

Claim 1 has been amended. Claims 2-14 depend from Claim 1 as amended. Claim 1 now recites an “article for association with a motor vehicle” comprising in combination with, among other elements, “elements coupled to the base, wherein the elements have at least two characteristics including color, shape, surface profile, surface finish, outline, material, and indicia, and wherein unique configurations of the article may be created by selecting elements with different combinations of the at least two characteristics.” Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

The subject matter recited in Claims 1-14 would not have been obvious over Van Houten under 35 U.S.C. § 103(a). Van Houten does not disclose, teach, or suggest the “article” as recited in Claims 1-14. Moreover, the suggestion to make the combination of “inserts” of Van Houten with “various designs, shapes, colors and profiles” has been taken from the Applicant’s own specification (using hindsight) which is improper. Furthermore, to transform the “wheel cover having interchangeable turbine pocket inserts” of Van Houten to the “article” recited in independent Claim 1 would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

Accordingly, the subject matter recited in Claim 1 (and corresponding Claims 2-14) considered as a whole, would not have been obvious to a person having ordinary skill in the art. The rejection of Claims 1-14 in view of Van Houten under 35 U.S.C. § 103(a) is improper. Therefore, Claims 1-14 are patentable over Van Houten.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of Claims 1-14.

Claim Rejections – 35 U.S.C. § 102

On page 5 of the Office Action, the Examiner rejected independent Claim 15 and dependent Claims 23 and 25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”).

Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

Claim 15 has been amended. Claims 23 and 25 depend from Claim 15 as amended. Claim 15 now recites a “set of articles for association with motor vehicles” comprising in combination with, among other elements, a “plurality of individual elements, wherein the individual elements of each set of elements have at least two characteristics including color, shape, surface profile, surface finish outline, material, and indicia, and wherein unique configurations of the articles may be created by selecting elements with different combinations of the at least two characteristics.” The “set of articles” as recited in Claim 15, as amended, is not identically disclosed by Van Houten. Accordingly, Claim 15 (and corresponding Claims 23 and 25) are not anticipated by Van Houten under 35 U.S.C. § 102(b) and are patentable.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of Claims 15, 23 and 25.

Claim Rejections – 35 U.S.C. § 103

On page 6 of the Office Action, the Examiner rejected independent Claim 15 and dependent Claims 16-27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”). The Examiner acknowledged that Van Houten differs from the claimed invention in that Van Houten does not specifically disclose the “profiles, color, footprint, and indicia associated with the inserts” of Claims 16-27. However, the Examiner stated Van Houten teaches that the “decorative inserts may be replaceable or interchangeable.” The Examiner thus concluded that “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the interchangeable inserts of Van Houten with

various designs, shapes, colors and profiles in order to decorate or accent a vehicle according to the users individual taste.”

Claim 15 has been amended. Claims 16-27 depend from Claim 15 as amended. Claim 15 now recites a “set of articles for association with motor vehicles” comprising in combination with, among other elements, a “plurality of individual elements, wherein the individual elements of each set of elements have at least two characteristics including color, shape, surface profile, surface finish outline, material, and indicia, and wherein unique configurations of the articles may be created by selecting elements with different combinations of the at least two characteristics.” Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

The subject matter recited in Claims 15-27 would not have been obvious over Van Houten under 35 U.S.C. § 103(a). Van Houten does not disclose, teach, or suggest the “set of articles” as recited in Claims 15-27. Moreover, the suggestion to make the combination of the “inserts” of Van Houten with “various designs, shapes, colors and profiles” has been taken from the Applicant’s own specification (using hindsight) which is improper. Furthermore, to transform the “wheel cover having interchangeable turbine pocket inserts” of Van Houten to the “sets of articles” recited in independent Claim 15 would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

Accordingly, the subject matter recited in Claim 15 (and corresponding Claims 16-27) considered as a whole, would not have been obvious to a person having ordinary skill in the art. The rejection of Claims 15-27 in view of Van Houten under 35 U.S.C. § 103(a) is improper. Therefore, Claims 15-27 are patentable over Van Houten.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of Claims 15-27.

Claim Rejections – 35 U.S.C. § 102

On page 7 of the Office Action, the Examiner rejected independent Claim 28 and dependent Claims 29, 31-32, and 34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”).

Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

Claim 28 has been amended for clarity. Claims 29, 31-32, and 34 depend from Claim 28 as amended. Claim 28 recites an “article prepared by a process” comprising in combination with, among other steps, “associating the article configuration with selected information.” The Examiner noted that product-by-process Claims are based on the product itself even though such Claims are limited and defined by the process. The Examiner further noted that a product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior art was made by a different process. The article of Claim 28 is not the same as or obvious from the product disclosed in Van Houten. Van Houten does not disclose an article with selected information associated with the article configuration. Accordingly, Claim 28 (and corresponding Claims 29, 31-32, and 34) are not anticipated by Van Houten under 35 U.S.C. § 102(b) and are patentable.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of Claims 28, 29, 31-32, and 34.

Claim Rejections – 35 U.S.C. § 103

On page 8 of the Office Action, the Examiner rejected dependent Claims 30, 31 and 33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”).

Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

Dependent Claims 30, 31 and 33 depend from independent Claim 28. Independent Claim 28 has been amended for clarity. Claim 28 recites an “article prepared by a process” comprising in combination with, among other steps, “associating the article configuration with selected information.” The Examiner noted that product-by-process Claims are based on the product itself even though such Claims are limited and defined by the process. The Examiner further noted that a product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior art was made by a different process. The article of Claim 28 is not the same as or obvious from the product disclosed in Van Houten. Van Houten does not disclose an article with selected information associated with the article configuration. Accordingly, the rejection of independent Claim 28 and corresponding dependent Claims 30, 31 and 33 under 35 U.S.C. § 103(a) is improper. Therefore, dependent Claims 30, 31 and 33 are patentable over Van Houten.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of Claims 30, 31 and 33.

Claim Rejections – 35 U.S.C. § 103

On page 8 of the Office Action, the Examiner rejected Claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,556,588 to Rockwood (“Rockwood”) or U.S. Patent No. 6,434,873 to Pierce (“Pierce”) in view of U.S. Patent No. 6,517,168 to Van Houten (“Van Houten”).

Rockwood discloses a “decorative emblem useful in customizing an automobile and other surfaces.” Pierce discloses an “ornamental display for achievement awards.” Van Houten discloses a “wheel cover having interchangeable turbine pocket inserts.”

The Examiner acknowledged that Rockwood or Pierce differ from the claimed invention in that Rockwood or Pierce do not specifically disclose “a plurality of inserts having different characteristics.” However, the Examiner stated that Van Houten “teaches an article such as a wheel cover having interchangeable inserts snapped into turbine pockets of a wheel cover.” The

Examiner thus concluded that “it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the emblem of Rockwood or the display device of Pierce by providing more cavities or depressions and placing the desired number of interchangeable decorative inserts in the cavities or depressions as taught by Van Houten to provide, for example, a vehicle to which the emblem or decorative display may be attached in order to give unique or the desired look and/or visual effect.”

Claims 1-14

Claim 1 has been amended. Claims 2-14 depend from Claim 1 as amended. Claim 1 now recites an “article for association with a motor vehicle” comprising in combination with, among other elements, “elements coupled to the base, wherein the elements have at least two characteristics including color, shape, surface profile, surface finish, outline, material, and indicia, and wherein unique configurations of the article may be created by selecting elements with different combinations of the at least two characteristics.”

The subject matter recited in Claims 1-14 would not have been obvious over Van Houten in view of Rockwood or Pierce under 35 U.S.C. § 103(a). Neither Rockwood or Pierce nor Van Houten, alone or in any proper combination, disclose, teach or suggest the “article” as recited in Claims 1-14. Moreover, the suggestion to make the combination of Rockwood or Pierce and Van Houten has been taken from the Applicant’s own specification (using hindsight) which is improper. Furthermore, to transform the combination of “ornamental display for achievement awards” or “decorative emblem useful in customizing an automobile and other surfaces” and “wheel cover having interchangeable turbine pocket inserts” to the “article” recited in independent Claim 1 would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

Accordingly, the subject matter recited in Claim 1 (and corresponding Claims 2-14) considered as a whole, would not have been obvious to a person having ordinary skill in the art. The rejection of Claims 1-14 over Rockwood or Pierce in view of Van Houten under 35 U.S.C. §

103(a) is improper. Therefore, Claims 1-14 are patentable over Rockwood or Pierce in view of Van Houten.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of Claims 1-14.

Claims 15-27

Claim 15 has been amended. Claims 16-27 depend from Claim 15 as amended. Claim 15 now recites a “set of articles for association with motor vehicles” comprising in combination with, among other elements, a “plurality of individual elements, wherein the individual elements of each set of elements have at least two characteristics including color, shape, surface profile, surface finish outline, material, and indicia, and wherein unique configurations of the articles may be created by selecting elements with different combinations of the at least two characteristics.”

The subject matter recited in Claims 15-27 would not have been obvious over Van Houten in view of Rockwood or Pierce under 35 U.S.C. § 103(a). Neither Rockwood or Pierce nor Van Houten, alone or in any proper combination, disclose, teach or suggest the “articles” as recited in Claims 15-27. Moreover, the suggestion to make the combination of Rockwood or Pierce and Van Houten has been taken from the Applicant’s own specification (using hindsight) which is improper. Furthermore, to transform the combination of “ornamental display for achievement awards” or “decorative emblem useful in customizing an automobile and other surfaces” and “wheel cover having interchangeable turbine pocket inserts” to the “set of articles” recited in independent Claim 15 would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

Accordingly, the subject matter recited in Claim 15 (and corresponding Claims 16-27) considered as a whole, would not have been obvious to a person having ordinary skill in the art. The rejection of Claims 15-27 over Rockwood or Pierce in view of Van Houten under 35 U.S.C.

§ 103(a) is improper. Therefore, Claims 15-27 are patentable over Rockwood or Pierce in view of Van Houten.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of Claims 15-27.

Claims 28-34

Claim 28 has been amended for clarity. Claims 29-34 depend from Claim 28 as amended. Claim 28 recites an “article prepared by a process” comprising in combination with, among other steps, a “associating the article configuration with selected information.”

The subject matter recited in Claims 28-34 would not have been obvious over Van Houten in view of Rockwood or Pierce under 35 U.S.C. § 103(a). Neither Rockwood or Pierce nor Van Houten, alone or in any proper combination, disclose, teach or suggest the “article” as recited in Claims 28-34. Moreover, the suggestion to make the combination of Rockwood or Pierce and Van Houten has been taken from the Applicant’s own specification (using hindsight) which is improper. Furthermore, to transform the combination of “ornamental display for achievement awards” or “decorative emblem useful in customizing an automobile and other surfaces” and “wheel cover having interchangeable turbine pocket inserts” to the “article” recited in independent Claim 28 would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

Accordingly, the subject matter recited in Claim 28 (and corresponding Claims 29-34) considered as a whole, would not have been obvious to a person having ordinary skill in the art. The rejection of Claims 28-34 over Rockwood or Pierce in view of Van Houten under 35 U.S.C. § 103(a) is improper. Therefore, Claims 28-34 are patentable over Rockwood or Pierce in view of Van Houten.

Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of Claims 28-34.

* * *

After amending the claims as set forth above, claims 1-34 are now pending in this Application. No new matter has been added. The Applicant submits that each and every outstanding rejection to the pending claims has been overcome, and the Application is now in condition for allowance. Favorable reconsideration of the Application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present Application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this Application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 8/7/03

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